

REMARKS

In the instant Office Action, claims 1-43 are listed as pending and all claims are subject to a restriction requirement.

The Examiner alleges that the following groups of claims define patentably-distinct inventions:

- I. Claims 1-30, drawn to chemical compounds, classified in classes 548, 546 and 544 in divers[sic] subclasses; and
- II. Claims 31-43, drawn to methods of eliciting agonist effects or antagonist effects from one or more of a somatostatin subtype receptor in a subject in need thereof, methods of treating divers[sic] diseases and conditions, and pharmaceutical compositions, all classified in class 514, divers[sic] subclasses.

The Examiner alleges that separate inventions exist because "compounds according to the formula (I) in Claim 1 are known, are used in materially different processes than the method claims in Group II." The Examiner cites FR 2.132.632 (Bornowski and Herzig) as disclosing compounds according to Applicants' Claim 1 and a method for preparing those compounds although Bornowski and Herzig do not characterize the compounds as somatostatin receptor subtype agonists or antagonists. The Examiner also alleges that searching the invention of the claims is burdensome because "the search required in the evaluation of claims in Group II under 35 U.S.C. 112, first paragraph, for determining the state of the art with respect to methods of treatment of all of the many diseases and conditions recited in the claims of Group II will be extensive."

Applicants respectfully traverse this requirement and request that all claims be examined together in this application for the reasons set forth below.

Applicants respectfully submit that, in general, an Examiner will not be able to search for a use of a compound without including the compound in the search. The Examiner has already illustrated this connection in his citation of FR 2.132.632 in which the Examiner was able to discover that compounds alleged to be those of Applicants' Claim 1 were "not characterized as somatostatin receptor subtype agonists or antagonists." Applicants further respectfully submit that all compounds in a utility application are required to have some type of utility. Applicants thus submit that the

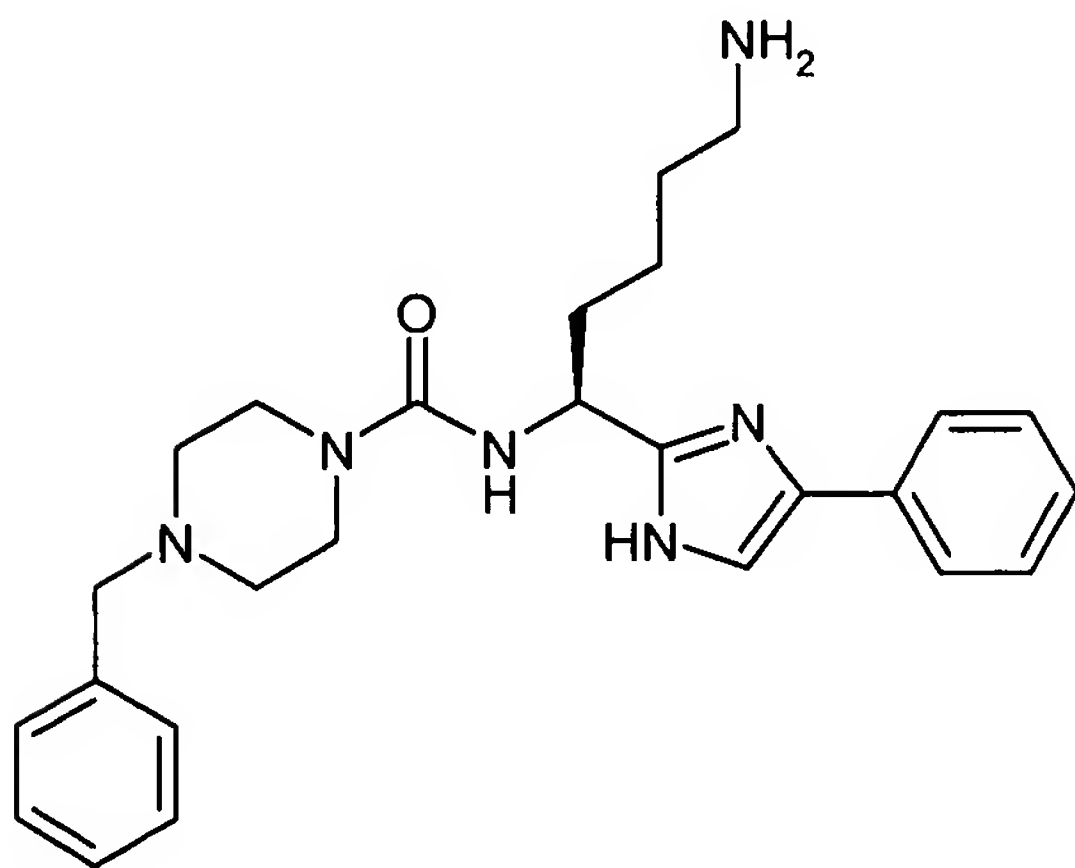
search for a compound in a claim of Group I will result in information regarding the potential use of that compound and thus is not an undue burden on the Examiner. As the treatment of the diseases and conditions presented in the claims of Group II all depend upon the administration of a compound of a claim of Group I, Applicant respectfully requests withdrawal of the restriction and that Claims 1-43 be examined together in the instant application.

Conclusion and Provisional Election:

Applicants submit that in view of the foregoing remarks, all of the claims herein are seen to relate to a single inventive concept, namely that derivatives of imidazolyl, and that the claims are in a form and are of the sort that is properly viewed as relating to a single invention that should not be restricted. Applicants respectfully request that the restriction requirement of the Office Action of September 14, 2004 be reconsidered and withdrawn.

Although, for reasons set forth above, Applicants believe that the restriction is improper, and without in any way acquiescing in the reasons for the requirements set forth in the Office Action, but in order to be fully responsive to the Office Action, Applicants provisionally elect for examination of the claims of Group I, *i.e.*, claims 1-30, drawn to chemical compounds.

As per the request of the Examiner on page 3, paragraphs 4 and 5, Applicants provisionally elect the compound species in which R¹ and R² are monovalent. In further compliance with 35 U.S.C. § 121, Applicants provisionally elect the following compound in which R¹ and R² are both H; Compound 8 as found in the "Formula 35" Table at page 200:



Also as per the request of the Examiner, Applicants note that the selected species reads upon Claim 1 and currently amended Claim 9.

Applicants state that withdrawal of the unelected subject matter does not require any amendment of inventorship pursuant to 37 C.F.R. 1.48(b).

Rejoinder

Applicants believe that method Claims 31-43 are subject to rejoinder upon the allowance of product Claims 1 and 22. As noted by the Examiner and in the MPEP821.04:

"[I]f Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined . . . Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance."

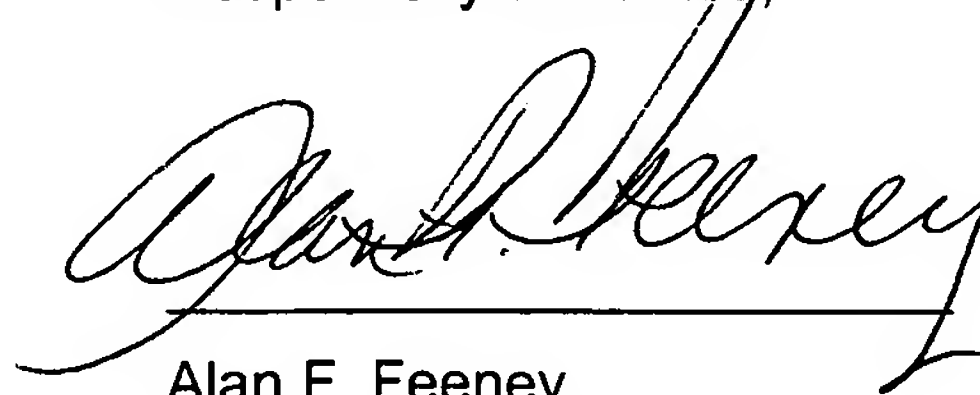
Applicants submit that Claims 31-36 currently incorporate the limitation of Claim 1 by the language "administering a compound according to claim 1." In a similar manner, Claims 37-43 currently incorporate the limitation of Claim 22 by the language "administering a compound according to claim 22." Therefore, Group II would be appropriate for rejoinder upon allowance of product claim 1 or 22.

Reconsideration of the instant Office Action and allowance of all pending claims are respectfully requested. Prompt and favorable action is solicited.

Respectfully submitted,

Date:

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